

BEST AVAILABLE COPY

11-18-05

16:12

From-CLARK & ELBING LLP

RECEIVED
CENTRAL FAX CENTER

+6174287046

T-666 P.002/008 F-002

NOV 18 2005**PATENT**
ATTORNEY DOCKET NO. 5034/056001Certificate of Facsimile Transmission: Date of Transmission: November 18, 2005

I hereby certify under 37 C.F.R. § 1.8(a) that this correspondence is being transmitted by facsimile to the Examiner R. DeBerry, Group Art Unit 1647, Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; Facsimile No. 571-273-8300.

Janet D'Annunzio-Ellis
Printed Name of Person Faxing Transmission

Janet D'Annunzio-Ellis
Signature of Person Faxing Transmission

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Carmeliet et al. Art Unit: 1647
Serial No.: 10/519,330 Examiner: R. DeBerry
§ 371 Date: April 25, 2005 Customer No.: 21559
Title: PLACENTAL GROWTH FACTOR AS A TARGET FOR THE
TREATMENT OF OSTEOPOROSIS

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO RESTRICTION REQUIREMENT

In reply to the Restriction Requirement that was mailed in connection with the above-captioned case on October 21, 2005, Applicants elect the invention of Group I, claims 1 and 9-14, and the species of "antibodies binding on placenta growth factor." Claims 1 and 9-13 read on the elected species. The election is made with traverse.

As an initial matter, as noted in the concurrently filed Preliminary Amendment, claim 14 has been canceled.

The Office asserts (page 3):

[C]laim 10 encompasses distinct compounds such as antibodies, nucleic acids, peptides, lipids, [and] macromolecules that are unrelated comprise different coding regions and/or imparts [sic] structural and functional differences.

Applicants submit that examination, in the present application, of all antagonists recited in claim 10 would not present an undue burden on the Office. The present claims are directed to Applicants' discovery that placenta growth factor plays an unexpected role in the process of bone resorption and, therefore, may be used in methods to treat disorders of bone resorption. Each of the antagonists recited in claim 10 shares the common function that forms the general inventive concept; they are all antagonists of placenta growth factor. As such, the antagonists are directed to a single general inventive concept as required by PCT Rule 13.1.

Moreover, the common function of the antagonists of claim 10 provides the special technical feature under PCT Rule 13.2. Rule 13.2 reads (in part):

The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

As noted above, Applicants discovered that antagonists of placenta growth factor affect bone resorption and, therefore, may be used in methods to treat disorders of bone resorption. All the compounds recited in claim 10 share this special technical feature. Accordingly, Applicants submit that the present species election requirement is improper under PCT Rule 13.2.

BEST AVAILABLE COPY

11-18-05

16:12

From-CLARK & ELBING LLP

+6174287046

T-666 P.004/008 F-002

In view of the above, Applicants respectfully request reconsideration of the Restriction Requirement.

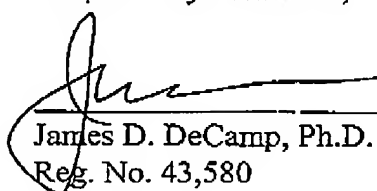
CONCLUSION

Applicants submit that the application is now in condition for allowance, and this action is hereby respectfully requested.

If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 18 November 2005


James D. DeCamp, Ph.D.
Reg. No. 43,580

Clark & Elbing LLP
101 Federal Street
Boston, MA 02110
Telephone: 617-428-0200
Facsimile: 617-428-7045